

REMARKS

Claims 1, 2, 4-15, and 17-27 are pending. Claims 12 and 25 are withdrawn. Claims 3 and 16 are canceled by this communication. Claims 1, 2, 4-11, 13-15, 17-24 and 26-27 are rejected.

Information Disclosure Statement

The Examiner alleges that the Information Disclosure Statement (IDS), specifically EP 0578998, filed on March 29, 2004 fails to comply with 37 CFR 1.98(a)(3). Applicants respectfully submit that the references other than EP 0578998 in the IDS were properly submitted under 37 CFR 1.98(a)(3). Applicants will submit a translation of EP 0578998 with a concise explanation of the relevance of this reference to cure this deficiency.

Rejections under 35 U.S.C. §112

Claims 1, 14, 17 and 24 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite.

The Examiner states that the terms recited in the claims, “less than about” and “mass % water” are indefinite. The claims are amended to replace these two terms with “less than” and “% water by mass”, respectively. Applicants believe the indefiniteness issue with respect to these two terms are moot.

The Examiner indicates that the phrases “the first polymer includes...” and “the second polymer includes...” recited in claim 1 render the claim indefinite because it is unclear what else constitutes the polymers. Applicants respectfully disagree. The term “include” is a common transition term to introduce features of the subject matter of a claim or features of an element in a claim, and, like the term “comprise”, the term “include” is not limited to features enumerated in the element or claim (see, MPEP §2111.03).

Claim 17 is amended to delete “the second polymer” and insert in place thereof the phrase “the biologically degradable polymer”, which has an antecedent basis in claim 14.

Rejections under 35 U.S.C. §103

Claims 1, 2, 4-11, 13-15, 18-24 and 26-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,395,326 to Castro et al. (“Castro”).

Claim 1 defines a medical article, comprising: (a) a medical substrate; and (b) a coating deposited on the substrate, the coating comprising a first polymer and a second polymer. The first polymer includes a biologically degradable AB block copolymer, and the second polymer includes a biologically degradable polymer having less than 5 % water by mass of the biologically degradable polymer. The AB block-copolymer is capable of absorbing, at equilibrium and at room temperature, about 5 % or more water by mass of the AB block-copolymer.

Claim 14 defines a medical article, comprising a first polymer and a second polymer. The first polymer includes a biologically degradable AB block copolymer, and the second polymer includes a biologically degradable polymer having less than 5 % water by mass of the biologically degradable polymer. The AB block-copolymer is capable of absorbing, at equilibrium and at room temperature, about 5 % or more water by mass of the AB block-copolymer.

Castro describes a composition that can be deposited onto a prosthesis. The composition can include one of polymers in a long list, which includes polycaprolactone (PCL), polycaprolactone-co-polyethylene glycol (PCL-co-PEG) (col. 12, lines 46-67). **Castro does not require the composition to include an AB block copolymer capable of absorbing about 5 %**

or more water by mass of the AB block-copolymer. Nor does Castro require a second polymer include less than 5% water by mass.

The Examiner dismisses the water absorbing capacity of the polymers as merely functional. Applicants respectfully disagree. **Water is known to be a plasticizer of a polymer. The water content in a polymer affects the mechanical properties of the polymer and the coating comprising the polymer. In addition, the water absorbing capacity of a polymer is an indication of hydrophilicity of the polymer. For example, in PCL-co-PEG, the PCL block is hydrophobic having a low water absorbing capacity, and the PEG block is hydrophilic having a high water absorbing capacity. The limitation of such a polymer having a water absorbing capacity of 5% or more by mass of the polymer would require the polymer to have an appropriate ratio of PCL block to the PEG block such that the polymer would achieve such a water absorbing capacity.** As the Examiner correctly notes, Castro certainly fails to teach any of these important features as defined in claims 1 and 14. As such, claims 1 and 14 are patentably allowable over Castro under 35 U.S.C. §103(a). Claims 2, 4-11 and 13 depending from claim 1, and claims 15, 18-24 and 26-27, depending from claim 14, are all patentably allowable over Castro under 35 U.S.C. §103(a) for at least the same reason.

Double patenting

Claims 1, 2, 4-11, 13-15, 17-24, and 26 are rejected under the doctrine of nonstatutory obviousness-type double patenting over claims 1-20 of U.S. Patent No. 7,229,471. Applicants believe the enclosed terminal disclaimer renders this rejection moot.

The undersigned authorizes the examiner to charge any fees that may be required or credit of any overpayment to be made to Deposit Account No. **07-1850**.

CONCLUSION

Withdrawal of the rejection and allowance of the claims are respectfully requested. **If the Examiner has any suggestions or amendments to the claims to place the claims in condition for allowance, applicant would prefer a telephone call to the undersigned attorney for approval of an Examiner's amendment.** If the Examiner has any questions or concerns, the Examiner is invited to telephone the undersigned attorney at (415) 393-9885.

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Respectfully submitted,

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